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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/290,027	04/09/1999	JOHN W. NOTZ	16356.431	9377
27683	7590	12/28/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			KAZIMI, HANI M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

09/290,027

Applicant(s)

NOTZ ET AL

Examiner

Hani Kazimi -

Art Unit

3624.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-10,12,13,15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-10,12,13,15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the Request for Continued Examination (RCE) filed on September 2, 2004.

#### ***Status of Claims***

2. Of the original claims 1-18, claims 2, 5, 7, 11, 14, and 16 have been canceled, and claims 1, 4, 8, 10, 13, and 17 have been amended in the amendment filed on March 21, 2002. In the amendment filed on September 16, 2002, claims 1, and 10 have been amended. In the amendment filed on March 19, 2003, claims 1, and 10 have been amended. In the amendment filed on September 5, 2003, claims 1, and 10 have been amended, and claims 19, and 20 have been added. In the amendment filed on September 2, 2004, claims 1, and 10 have been amended, and claims 21-24 have been added. Therefore, claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-24 are under prosecution in this application.

#### ***Summary of Office Action***

3. Applicants' arguments filed on September 2, 2004 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. 102 are not deemed to be persuasive. Therefore, claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-24 are rejected as being unpatentable over the art cited below, and Applicant's request for allowance is respectfully denied.

***Response to Applicants' Amendment***

***Claim Rejections – 35 USC 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention thereof by the applicant for patent.

5. Claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson et al. US Pat. No. 6,167,383.

Claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson et al. US Pat. No. 6,167,383 as discussed in previous office action mailed on March 1, 2004. Further:

Henson teaches the claimed limitation, wherein if after exiting the cart without accepting an upsell recommendation and upon later reentering that cart, a different upsell recommendation is offered, and a next upsell recommendation in a given priority order is displayed as the different upsell recommendation (column 15, lines 3-67, column 7, lines 21-38, and column 9, lines 40-67).

***Response to Arguments***

6. Applicant's arguments filed on September 2, 2004 have been fully considered. The response to Applicant's arguments (with respect to claim 1) has been addressed in previous

office actions mailed on June 30, 2004 and November 19, 2002 . The newly added claims are rejected as mentioned above within the 35 U.S.C. 102 rejections of this office action.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



HANI M. KAZIMI  
PRIMARY EXAMINER  
Art Unit 3624

November 29, 2004